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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONALD F. HAMILTON and MICHAEL D. ROSEN

Appeal 2007- 3091
Application 08/777,958
Technology Center 2600

Decided: March 11, 2008

Before ANITA PELLMAN GROSS, MAHSHID D. SAADAT,
and JOHN A. JEFFERY, *Administrative Patent Judges*.

SAADAT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1, 3-6, and 8-10, which are all of the claims pending in this application as claims 2 and 7 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).¹

Appellants' invention relates to the placement of a low frequency audio speaker to affect improved frequency response in the interior of a

¹ An oral hearing for this application was held on February 14, 2008.

vehicle with a trunk speaker that occupies negligible useful trunk volume (Spec. 1).

Independent Claim 1 is representative and reads as follows:

1. An audio speaker system for a vehicle having a passenger compartment, a spare tire compartment, a trunk having a trunk floor, a dividing portion and a rear deck, said dividing portion and said rear deck dividing the trunk and the passenger compartment, said audio speaker system comprising at least one low frequency speaker disposed within the trunk of the vehicle at the trunk rear in a location spaced from the passenger compartment by the portion of the trunk extending to the front of said vehicle such that said at least one speaker is clear of the rear deck above said trunk floor and outside said spare tire compartment,

wherein said at least one speaker is disposed in a rearward section of the trunk occupying negligible useful trunk volume to cause a smaller decrease in calculated trunk volume than would occur with said at least one speaker mounted in said rear deck.

The Examiner relies on the following prior art in rejecting the claims:

Amy Ziffer, *Family Affair*, May 1991, Car Audio and Electronics, pp. 38-42, herein referred to as “Ziffer (May).”

Amy Ziffer, *Pursuit of Perfection*, March 1991, Car Audio and Electronics, pp. 46-50, herein referred to as “Ziffer (March).”

BAZOOKA Bass Tubes advertisement, January 1990, Car Audio and Electronics, p. 41, herein referred to as “Bazooka.”

Claims 1, 3-6, and 8-10 stand rejected under the first paragraph of 35 U.S.C. § 112 for lack of an enabling disclosure related to the position of the speaker in the rearward section of the trunk occupying negligible useful trunk volume.

Claims 1, 3-6, and 8-10 stand rejected under the second paragraph of 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellants regard as their invention.

Claims 1, 3, and 4 stand rejected under 35 U.S.C. § 102(a) as being anticipated by Ziffer (May).

Claims 1, 3, and 4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ziffer (May) and Bazooka.

Claims 1, 3-6, and 8-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ziffer (March) and Bazooka.

Rather than repeat the arguments here, we make reference to the Briefs and the Answer for the respective positions of the Appellants and the Examiner.

We reverse.

ISSUES

1. Under the first paragraph of 35 U.S.C. § 112, with respect to appealed claims 1, 3-6, and 8-10, would the skilled artisan have recognized Appellants' disclosure as an enabling disclosure?

2. Under the second paragraph of 35 U.S.C. § 112, with respect to appealed claims 1, 3-6, and 8-10, would the claims reasonably apprise those of ordinary skill in the art of their scope?

3. Under 35 U.S.C. § 102(a), with respect to appealed claims 1, 3, and 4, does Ziffer (May) anticipate the claimed subject matter by teaching all of the claimed limitations?

4. Under 35 U.S.C § 103(a), with respect to appealed claims 1, 3, and 4, would one of ordinary skill in the art at the time of the invention have found it obvious to combine Ziffer (May) with Bazooka to render the claimed invention unpatentable?

5. Under 35 U.S.C § 103(a), with respect to appealed claims 1, 3-6, and 8-10, would one of ordinary skill in the art at the time of the invention have found it obvious to combine Ziffer (March) with Bazooka to render the claimed invention unpatentable?

PRINCIPLES OF LAW

Enablement

To be enabling, the specification must teach those of ordinary skill in the art “how to make and how to use the invention as broadly as it is claimed.” *In re Vaeck*, 947 F.2d 488, 496 (Fed. Cir. 1991). Furthermore, the specification, when filed, must enable one skilled in the particular art to use the invention without undue experimentation. *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988). *See also Spectra Physics v. Coherent*, 827 F.2d 1524, 1533 (Fed. Cir. 1987).

Indefiniteness

Analysis of 35 U.S.C. § 112, second paragraph, should begin with the determination of whether claims set out and circumscribe the particular area with a reasonable degree of precision and particularity; it is here where definiteness of the language must be analyzed, not in a vacuum, but always in light of teachings of the disclosure as it would be interpreted by one

possessing ordinary skill in the art. *In re Johnson*, 558 F.2d 1008, 1015 (CCPA 1977), *citing In re Moore*, 439 F.2d 1232, 1235 (1971). “The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope.” *In re Warmerdam*, 33 F.3d 1354, 1361 (Fed. Cir. 1994) (*citing Amgen Inc. v. Chugai Pharmaceutical Co. Ltd.*, 927 F.2d 1200, 1217 (Fed. Cir.), *Genetics Inst., Inc. v. Amgen, Inc.*, 112 S. Ct. 169 (1991)). Furthermore, our reviewing court points out that a claim which is of such breadth that it reads on subject matter disclosed in the prior art is rejected under 35 U.S.C. § 102 rather than under 35 U.S.C. § 112, second paragraph. *See In re Hyatt*, 708 F.2d 712, 715 (Fed. Cir. 1983).

Anticipation

A rejection for anticipation under section 102 requires that each and every limitation of the claimed invention be disclosed in a single prior art reference. *See In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994). Anticipation of a claim requires a finding that the claim at issue reads on a prior art reference. *Atlas Powder Co. v. IRECO Inc.*, 190 F.3d 1342, 1346 (Fed. Cir. 1999) (quoting *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 781 (Fed. Cir. 1985)).

Obviousness

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. *See In re Kahn*, 441 F.3d 977, 987-88 (Fed. Cir. 2006), *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991), and *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

The Examiner can satisfy this burden by showing some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR Int'l. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (*citing In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

ANALYSIS

1. 35 U.S.C. § 112, first paragraph, rejection

The Examiner's position is focused on the presence of information in Appellants' disclosure related to how a low frequency speaker of the size and shape necessary to be employed in the claims may be produced (Ans. 5). The Examiner relies on one of the applied prior art references, Ziffer (March), which identifies Bazooka speakers as the most compact speakers available at the time of invention (*id.*). The Examiner takes the position that since Appellants acknowledge the existence of Bazooka speakers and the large space they occupy when placed in the trunk of a car, such an acknowledgment supports the fact that Appellants' disclosure is non-enabling (Ans. 16).

We agree with Appellants that the above mentioned recognition of the large size of Bazooka speakers does not support the lack of an enabling disclosure (App. Br. 5; Reply Br. 3). Furthermore, as pointed out by Appellants (*id.*), we find that Figure 2 of the instant Specification discloses the placement of the speaker enclosure 9 in the corner of the vehicle trunk occupying negligible useful trunk volume (Spec. 2:17-20) while the trunk as a whole acts as a natural low-pass filter (Spec. 2:25-27). Therefore, in view of the above discussion and considering the presented facts and the

arguments made by Appellants and the Examiner, we find that Appellants' disclosure is enabling, and the rejection of claims 1, 3-6, and 8-10 under the first paragraph of 35 U.S.C. § 112 cannot be sustained.

2. *35 U.S.C. § 112, second paragraph, rejection*

The Examiner takes the position that since the amount of useful trunk volume occupied by the speaker varies based on the type of the vehicle, the claim recitation of "negligible useful trunk volume" renders the claims indefinite (Ans. 6-7, 18). Appellants contend that the Specification fully explains the disputed limitation and refer to the prior Board decision in the parent application which did not sustain a similar rejection made by the Examiner (App. Br. 7-8; Reply Br. 5).

Similar to our discussion *supra* with regard to the lack of enablement, we find that Page 2 of Appellants' Specification defines what useful trunk volume is and how, by their placement in a corner of the trunk, the speakers occupy a negligible trunk space. Furthermore, the ordinary meaning of the term "negligible," as understood by one of ordinary skill in the art and as defined in a dictionary as "so small or unimportant or of so little consequence as to warrant little or no attention,"² is consistent with Appellants' disclosure. As such, the claimed term "negligible useful trunk volume" reasonably apprises those of skill in the art of its scope, and the rejection of claims 1, 3-6, and 8-10 as being indefinite under the second paragraph of 35 U.S.C. § 112 is not sustained.

² Merriam-Webster's Online Dictionary, at <http://www.merriam-webster.com> (last visited Feb. 19, 2008).

3. *35 U.S.C. § 102(a) rejection*

Appellants contend that Ziffer (May) shows in the accompanying pictures a pair of speakers placed in the side of a trunk in such a way that “one foot on each side” must be given up wherein similar space is occupied on the bottom (App. Br. 11). We agree with Appellants that the arrangement disclosed by the reference shows substantial volume taken up by the placement of the speakers. As we discussed above in relation to the issue of indefiniteness, the word “negligible” is defined by Appellants such that one of ordinary skill in the art would have clearly understood it as referring to such a small space that it differs from the space taken up by the speakers in Ziffer (May).

We also disagree with the Examiner (Ans. 21) that any speaker that is placed in the rear corner position of the trunk would inherently occupy negligible trunk volume. In that regard, we note that the speakers disclosed in Ziffer (May), although occupying the rear corner of the trunk, do not appear to occupy a negligible trunk space. Accordingly, the 35 U.S.C. § 102(a) rejection of claims 1, 3, and 4 as anticipated by Ziffer (May) is not sustained.

4. *35 U.S.C. § 103(a) rejections*

With respect to the rejection of claims 1, 3, and 4 over Ziffer (May) in view of Bazooka, Appellants argue that the Bazooka reference similarly shows the large Bazooka bass tubes extending from front to rear in the trunk (App. Br. 13). Appellants assert that the Examiner has not shown that the disclosed arrangement of the speakers shows a negligible trunk volume

being occupied in either reference (*id.*). We again agree with Appellants and find the Examiner's position (Ans. 21) with respect to finding the space taken up by the prior art speakers as negligible to be unreasonable. As discussed above with respect to the anticipation rejection and as argued by Appellants (Oral Hearing), both Ziffer (May) and Bazooka show speaker placements that occupy substantial trunk volume and cannot teach or suggest the claimed requirements. Therefore, we do not sustain the 35 U.S.C. § 103(a) rejection of claims 1, 3, and 4 over Ziffer (May) and Bazooka.

Regarding, the rejection of claims 1, 3-6, and 8-10 over Ziffer (March) in view of Bazooka, we also disagree with the Examiner's position based on substantially the same reasons stated above. As such, since we find that the Bazooka speakers occupy substantial trunk volume, we do not sustain the 35 U.S.C. § 103(a) rejection of claims 1, 3-6, and 8-10 over Ziffer (March) and Bazooka.

CONCLUSION

On the record before us and in view of our analysis above, we have not sustained the 35 U.S.C. § 112, first paragraph or second paragraph, rejections of claims 1, 3-6, and 8-10. We have also not sustained the 35 U.S.C. § 102(a) rejection of claims 1, 3, and 4, nor the 35 U.S.C. § 103(a) rejections of claims 1, 3-6, and 8-10.

Therefore, the Examiner's decision rejecting claims 1, 3-6, and 8-10 is reversed.

REVERSED

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Application 08/777,958

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